



INTELLECTUAL PROPERTY

CASEBOOK

VOLUME 1

FALL 1988

Professor R.J. Coombe

FACULTY OF LAW  
UNIVERSITY OF TORONTO

LAW LIBRARY

SEP 27 1988


FACULTY OF LAW  
UNIVERSITY OF TORONTO

INTELLECTUAL PROPERTY

CASEBOOK

VOLUME 1

FALL 1988



Digitized by the Internet Archive  
in 2018 with funding from  
University of Toronto

INTELLECTUAL PROPERTY  
FALL 1988  
TABLE OF CONTENTS

R.J. Coombe

I INTRODUCTION

Volume 1

	<u>Page</u>
II COPYRIGHT .....	1
A. <u>History and Policy Considerations</u> .....	1
Kaplan, An unhurried view of copyright (1967) .....	1
White-Smith Music Co. v. Apollo Co. (1907) .....	8
"A Charter of Rights for Creators" A report of the House of Commons Standing Committee on Communications and Culture's Subcommittee on the Revision of Copyright (1985) .....	9
Ladbroke (Football) Ltd. v. Wm. Hill (Football) Ltd. [1964] .....	10
Breyer "The Uneasy Case for Copyright" (1970) .....	10
Report on Intellectual and Industrial Property Economic Council of Canada, 1971 .....	13 ✓
Jeanne Thomas Allen "Copyright and Early Theater, Vaudeville, and Film Competition" In <u>Film Before Griffith</u> edited by John Fell, (California, Los Angeles, 1983) .....	17
Fidel Castro "Communism will be Abundance Without Egoism: On Intellectual Property", 1967. In <u>Communication and Class Struggle Volume 2 Liberation, Socialism</u> (New York, 1983) .....	23
Poster for a Festival of Plagiarism, San Francisco, February, 1988 ..	27
B. <u>Authorship and Ownership</u> .....	29
Who is protected? Bill C-60 s. 4-12 and Commentary .....	29
Donahue v. Allied [1983] .....	35
University of London Press Ltd. v. University Tutorial Press Ltd. [1916] .....	41
Jorge Luis Borjes "Pierre Menard: Author of the <u>Quixote</u> " in <u>Labyrinths</u> (New York: New Directions, 1962) .....	43
Walter Benjamin "Author as Producer" In <u>The Essential Frankfurt School Reader</u> edited by Andrew Arato (1978) .....	48
Michael Foucault "What is an Author?" In <u>Foucault Reader</u> edited by Paul Rabinow (Pantheon, 1984) .....	57
Janet Wolff "The Death of the Author" in <u>The Social Production of Art</u> (NY: NYU, 1984) .....	69
Roland Barthes "The Death of the Author" in <u>Image/Music/Text</u> trans. Stephen Heath (New York: Hill and Wang, 1977) .....	80

C.	<u>Ideas and Expressions, Originality and Fixation</u> .....	83
1.	Bill C-60 s. 1-2 and commentary .....	83
2.	<u>Case Law</u> .....	86
	University of London Press Ltd. v. University Tutorial Press Ltd. [1916] .....	86
	Ladbroke Ltd. v. Wm. Hill Ltd. [1964] .....	87
	Victoria Park Racing Co. v. Taylor (1937) .....	87
	Martin v. Polyplas Manufacturers Ltd. [1969] .....	87
	Cuisenaire v South West Imports Ltd. [1968] .....	89
	B.C. Jockey Club v Standen (1985) .....	90
i)	Compilations .....	93
	Ladbroke (Football) Ltd. v Wm Hill (Football) Ltd. [1964] .....	93
	Express Newspapers Plc. v. Liverpool Daily Post Plc. [1985] ...	96
	Elanco Products Units v. Mandops [1979] .....	99
ii)	Titles .....	104
	Francis Day & Hunter Ltd. v. Twentieth Century Fox Corp. Ltd. [1940] .....	104
	Exxon v Exxon Insurance Consultants [1982] .....	107
iii)	Fixation .....	112
	Canadian Admiral Corp. Ltd. v Rediffusion Inc. [1954] .....	112
iv)	Originality .....	124
	Hal Foster "The Expressive Falacy" In <u>Recodings: Art, Spectacle, Cultural Politics</u> pp. 59-71; 217-8 (Bay Press, 1985) ....	124
D.	<u>Selected Subject Matters</u> .....	134
1.	Comment: Subject matter .....	134
2.	Computer Programs .....	139
	Comment: White Paper on Computer Programs .....	139 ✓
	Apple Computer v MacIntosh Computers Ltd. (1987) .....	144
3.	Musical Works .....	157
i)	Comment .....	157
ii)	Cases .....	157
	Canadian Performing Right Society v. Ford Hotel [1935] .....	157
	Ludlow Music Inc. v. Canint Music Corp. [1967] .....	161
	Nancy Sinatra v Goodyear Tire & Rubber (1970) .....	168
iii)	Substantial Part .....	173
	Hawkes v Paramount (1934) .....	173
iv)	Making Music: Where does Creativity lie? .....	180
	Dick Hebdige "Rap and Hip Hop: The New York Connection" In <u>Cut'n'Mix: Culture, Identity and Caribbean Music</u> pp. 136- 148 (Methuen 1987) .....	180
	Iain Chambers "Moving on up: Black music and into the '80's" In <u>Popular Culture: The Metropolitan Experience</u> pp 164- 180 (Methuen, 1986) .....	188
	Jon Pareles "Digital Technology Changing Music" New York Times, October 16, 1986, pg. C-23 .....	196

E.	<u>Acts of Infringement and Exemptions</u> .....	197
	Bill C-60 s. 17 and commentary .....	197
1.	Infringement .....	206
	Francis Day & Hunter Ltd. v Bron [1963] .....	212
	King Features Syndicate Inc. v. O & M Kleeman Ltd. [1941] .....	212
	Deeks v Wells (1930); [1930]; [1933] .....	215
	Bishop v Tele-Metropole (1985) .....	218
	A & M Records v Millbank (1985) .....	229
2.	Fair Use or Fair Dealing .....	233
	Hubbard v Vosper [1972] .....	233
	Lion Laboratory Ltd. v. Evans [1985] .....	237
	The Queen v James Lorimer & Co. Ltd. (1984) .....	241
	Sony v Universal City Studios (1984) .....	247
F.	<u>Artist's Moral Rights</u> .....	253
	"Artists Don't Deserve Special Rights" (1988) Wall Street Journal..	253
	Bill C-60 and Comment .....	254
	Snow v The Eaton Centre Ltd. (1982) .....	256
	John Maryon Intl Ltd. v New Brunswick Telephone Co. (1983) .....	257
	Molotsky "Colored Movies Ruled Eligible for Copyright" (1987) N.Y. Times .....	259
	Oman "Black and White and Red All Over" (1987) N.Y. Times .....	260
	Allen "The Colorization of Film Insults Artists and Society" (1987) N.Y. Times .....	262
G.	<u>Collective Rights to Cultural Heritage</u> .....	263
	"Thais Accuse U.S. of Theft of Temple Art" (1988) N.Y. Times .....	263
	Bennetts "'Colouring' Film Classics: A Boon or A Bane?", "Debate Goes On Over Colorization" N.Y. Times, Aug. 5/86 April 17/87 .....	264
	"Share the Blame: The Spirit Sings" (1988) <u>Vanguard</u> .....	266
H.	<u>Remedies</u> .....	271
	Nintendo of America v. Coinex Video Games Inc. .....	271
	IBM Corp. v. Ordinateurs Spirales Inc. .....	276
	Gribble v. Manitoba Free Press Ltd. .....	279
	Pro Arts, Inc. v. Campus Crafts Holdings Ltd. .....	280
	Sheldon v. Metro-Goldwyn Pictures Corp. .....	289
III	<b>INDUSTRIAL DESIGN</b> .....	296
	Comment .....	296
	Doral Boats Ltd. v. Bayliner Marine Corp. (1986) .....	298
	Spiro-Flex Industries Ltd. v. Progressive Sealing Inc. (1986) .....	303
	King Features Syndicate Inc. v. O.M. Kleeman Ltd. [1941] .....	312
	Hayhurst (1979) 11 Ottawa L. Rev. 391, 469-80 .....	318
	Rucker Co. v. Gavel's Vulcanizing Ltd. (1986) .....	326



Volume 2

IV	TRADEMARKS .....	329
A.	<u>The Law and Its Policy Bases</u> .....	329
	Schechter (1927) "The Rational Basis of Trademark Protection" 40 Harv. L.R. 813, 814-21 .....	329
	Standard Brands Inc. v. Smidler (1945) .....	332
	Roberts, J.R. "Functions of a Trademark" .....	337
	Cohen, (1935) "Transcendental Nonsense and the Functionalist Approach" .....	339
B.	<u>Common Law</u> .....	364
	i) Establishing Goodwill .....	364
	Blades Enterprises v Thibault .....	364
	Erven Warnick Besloten Vennootschap v J. Townend & Sons [1979] .....	366
	ii) Distinctive Character .....	372
	Cadbury Schweppes Pty Ltd. v. Pub. Squash Co. Pty. Ltd. [1981] .....	372
	iii) Misrepresentation .....	378
	Consumers Distributing Co. v Seiko Time Canada Ltd. (1984) ...	378
	iv) Territorial Extent of Reputation .....	390
	Orkin Exterminating Co. Inc. v Pestco of Canada Ltd. (1985) ..	390
	v) Unfair Competition .....	403
	INS v Associated Press 248 U.S. 215 (1918) .....	403
	Moorgate Tobacco Co. Ltd. v Philip Morris Ltd. (1984) .....	415
	vi) Misappropriation .....	418
	Board of Trade of the City of Chicago v Dow Jones & Company (1983) .....	418
	vii) Damages .....	425
	R.C.A. Corp. v. Pollard (1983) .....	425
	Ratcliffe v Evans [1892] .....	429
	S & S. Industries v Rowell [1966] .....	430
C.	<u>Statutory Trademarks</u> .....	436
1.	<u>Section 2 of the Trademark Act</u> .....	436
	i) Commentary on distinctiveness, certification marks, distinguishing guises, proposed trademarks, trade names .....	436
	ii) Distinctiveness .....	439
	Great Lakes Hotels Ltd. v. The Noshery Ltd. (1968) .....	439
	E & J Gallo Winery v Andres Wines Ltd. (1976) .....	442
	Valle's Steak House v. Tessier (1980) .....	447
	"Battle of the Soaps" Toronto Star, 1986 .....	450
	S.C. Johnson and Son Ltd. v Marketing International Ltd. (1980) .....	451
	iii) Trade names .....	453
	C.B.C.A./Regs .....	453



	O.B.C.A./Regs .....	462
	Re: Federation of Women's Teachers Association (1984) .....	462
2.	<u>Trademark Registration</u> .....	468
	Commentary .....	468
3.	<u>Characteristics of a Registrable Trade Mark</u> .....	469
	i) Section 12 (1) .....	469
	a) Primarily name or surname .....	469
	Comment .....	469
	Deputy A.G. v McDonald's Corp. [1976] .....	470
	Hurlbut Co. v Hurlbut Shoe Co. (1925) .....	472
	Elder's Beverages (1975) Ltd. v. Registrar of Trademarks (1979) .....	476
	b) Clearly descriptive or deceptively misdescriptive .....	479
	S.C. Johnson and Son Ltd. v. Marketing International Ltd. [1980] .....	479
	Molson Companies Ltd. v. John Labatt Ltd. (1984) .....	483
	Great Lake Hotels v Noshery Ltd. (1968) .....	488
	c) Name in any language .....	492
	Comment .....	492
	d) Marks which become generic .....	492
	Aladdin Industries, Inc. v. Canadian Thermos Products Ltd. et. al (1969) .....	492
	Xerox ad .....	504
	e) Mere functionality .....	505
	W. Edge & Sons Ltd. v. W. Niccols & Sons Ltd. (1911) .....	505
	Parke, Davis & Co. v. Empire Labs Ltd. (1964) .....	510
	Smith Kline & French v Sterling-Winthrop [1975] .....	513
	Notes .....	515
	ii) Section 12 (2): Secondary Meaning .....	???
4.	<u>Confusing Trademarks</u> .....	517
	i) Comment .....	517
	ii) Resemblance in Ideas Suggested .....	518
	Rowntree v. Paulin Chambers Co. [1968] .....	518
	Benson & Hedges v St. Regis Tobacco [1969] .....	521
	Conde Nast .....	524
5.	<u>Prohibited Trademarks</u> .....	527
	i) Section 9, 10 .....	527
	Comment from Hayhurst (1987) "Recent Developments in Canadian Law: Intellectual Property ..." 19 Ottawa L.R. 581, 629-30 .....	527
6.	<u>Offences</u> .....	529
	i) Section 7 Infringements .....	529
	Comment .....	529
	Clairol International Corp. v. Thomas Supply & Equip. Co. Ltd. (1968) .....	533
	Universal City Studios Inc. v 309848 Ontario Ltd. and Webber (1975) .....	540

ii)	Constitutionality .....	542
	MacDonald v Vapour Canada Ltd. (1976) .....	542
	Motel 6 Inc. v No. 6 Motel Ltd. (1981) .....	553
	Asbjorn Horgard A/S v Gibbs/Nortac (1987) .....	561
iii)	Expungements and amendments .....	574
iv)	Criminal Code Provisions .....	574
V	RIGHTS TO PERSONALITY/PUBLICITY: REAL, FICTIONAL AND SIMULATED PEOPLE (AND LIKE CREATURES) .....	576
A.	<u>Commercial Appropriation of Personality:</u> .....	576
	Section 9 of Trademark Act .....	576
	Nancy Sinatra v Goodyear Tire & Rubber Co. (1970) .....	576
	Krouse v Chrysler Canada Ltd. (1973) .....	579
	Athans v Canadian Adventure Camps Ltd. (1977) .....	588
	Heath v West - Barron School of Television Canada Ltd. (1981) .....	592
	Carson v Reynolds (1980) .....	594
B.	<u>Privacy Rights</u> .....	597
	Privacy Act R.S.B.C. 1979, c. 336 .....	597
C.	<u>Publicity Rights</u> .....	599
	Carson v Here's Johnny Portable Toilets, Inc. (1983) .....	599
D.	<u>A Trademark's "Persona"?</u>	
E.	<u>Tort, Trademark or Copyright Principles?</u>	

### Volume 3

VI	PATENTS .....	608
A.	<u>Introduction: History of Patents</u> .....	608
1.	Common Law - British United Shoe v Fussell (1908) .....	608
2.	Statutory History - evolution of the Canadian Patent System .....	611
3.	New developments - proposed amendments to the Canadian Patent Act..	612
4.	Selected Social History: Jeanne Thomas Allen "The Industrial Context of Film Technology: Standardization and Patents" In <u>The Cinematic Apparatus</u> Edited by Teresa De Lauretis and Stephen Heath (London: MacMillan, 1980) .....	614
5.	Procedure - How to obtain a Patent .....	620
	Typical Canadian Patent .....	623
B.	<u>Conditions For Patentability</u> .....	628
1.	Subject Matter: .....	628
i)	Unpatentable matter - methods, plans and business schemes - Coopers Application, Fishburn Application .....	630
ii)	Section 28(3) .....	631
a)	Illicit Object .....	631

b)	Abstract Principles or Laws of Nature .....	631
iii)	Computer Software and Patentability .....	632
	Diamond v. Diehr .....	632
	Schlumberger Canada Ltd. v. Comm. of Patents .....	634
	Millard, "Is Patent Protection available for Programs?" (1984) 1 Computer Law 62-64 .....	635
iv)	Biotechnology: Patentability of Life Forms .....	638
a)	Cases .....	638
	Diamond v. Chakrabarty .....	638
	Abitibi Case .....	641
	Pioneer Hi-bred case .....	646
b)	Section 36 (1) Deposit Requirement .....	648
c)	Advisory Committee Presentation .....	649
d)	U.S. Position: Non naturally occurring non-human animals..	652
2.	The Quality of Invention .....	654
i)	Comment: Section 2 cases .....	654
ii)	Ingenuity or nonobviousness .....	655
	Lowe-Martin Co. Ltd. v. Office Speciality Mfg. Co. Ltd. ....	655
	Re: Application of Menendez .....	658
	Hercules Inc. v. Commissioner of Patents .....	658
	Hughes "Degree of Inventiveness required to support a Patent Application in Canada" (1987) 3(1) Can. Intel. Prop. R. 40-46 .....	659
	Note: Inventive Ingenuity .....	662
iii)	Unsuspected Advantage or Accidental Discovery .....	663
	Smith v Goldie .....	663
iv)	How Trite: The Problem of 20/20 Hindsight .....	667
	Van der Lely v Banfords .....	667
	Aster-Hill Ltd. v Ayers Ltd. ....	667
	Woodrow v Long Humphreys .....	667
3.	Novelty .....	671
i)	Introduction: Section 28, 28.1 and 29 .....	671
ii)	Discussion of Proposed Amendments .....	673
iii)	Anticipation .....	675
a)	Prior Application .....	675
b)	Prior Disclosure .....	675
I.	By publication .....	676
	Beloit Canada Ltd. v. Valmet Oy .....	676
	Cluett, Peabody v Dominion Textile .....	680
	Saunders v Airglide Deflectors .....	681
II.	By public use or sale .....	682
	Leithser v Pengo Hydra pull .....	682
III.	Exceptions: Experiment or amusement .....	683
	Canadian Patent Scaffolding v Delzotto Enterprises..	683
c)	Prior Knowledge .....	688
	Marzone Chemicals v. Eli-Lilly .....	689
	Proctor & Gamble v Bristol-Myers .....	689

4.	Utility .....	690
	Hammond, (1984) "Inutility Attacks on Canadian patents".....	690
	Excerpts from Patent Office Procedural Manual .....	696
C.	<u>Patent Infringement</u> .....	696
1.	Acts constituting infringement .....	696
	i) use or sale .....	696
	ii) importing or exporting .....	696
	iii) transporting .....	696
	iv) resale .....	696
	v) inducing infringement .....	697
	Slater Steel Industries v. R. Payer .....	697
	vi) Reconstruction v. Repair .....	709
	vii) Complications .....	710
	a) Doctrine of equivalency .....	710
	b) Infringement Prior to Issue .....	711
2.	Acts Not Constituting Infringement .....	712
	i) Use for Amusement .....	712
	ii) Use for Experiment .....	712
	iii) Use in Foreign Vessels or Aircraft .....	712
D.	<u>Licensing</u> .....	713
	1. General Considerations .....	713
VII	TRADE SECRETS AND CONFIDENTIAL INFORMATION .....	714
A.	<u>Basis for protection: property or contract?</u> .....	714
	Triplex Safety Glass Co. v. Scolah .....	714
	Sprioll Corp. v. Putti et al .....	715
B.	<u>Can "information" be property?</u> .....	723
	Stewart v. Q. ....	723
C.	<u>Boing, boing: the springboard doctrine!</u> .....	737
	Saltman Engineering Case .....	738
	Ridgewood Resources Case .....	738
	Richardson Broadcasters v. Smith .....	743
D.	<u>Confidential information and trade secrets: fiduciary duty</u> .....	745
	Can Aero Services v. O'Malley et al .....	745
	Article: Corporate Opportunity and Confidential Information: Birds of a Feather that Flock Together or Canaeros of a Different Colour? .....	756
	International Corona v. LAC Minerals .....	760

E.	<u>Particular problems to be considered</u> .....	774
i)	Unsolicited disclosures from Outsiders .....	774
	W. F. Holte v. Kemp Mfg .....	774
	Hisel v. Chrysler .....	776
ii)	Rights in Employee Skills and Against Corporate Raiders .....	777
	B. F. Goodrich v. Wohlgemuth .....	777
	Capitol Records Case .....	779
iii)	Liability of Third Parties .....	781
	B.I.P. v. Ferguson .....	781
	Stevenson, Jordan & Harrison Case .....	782
	Printers & Finishers v. Holloway .....	783
	Int'l Tools v. Kollar et al .....	784
F.	<u>Proposed legislation</u> .....	788



